

Remarks

A. Claims In The Case

Claims 41, 42, 44, 45, 47, 48, 50, 52, 53, 55-60, 62, 64, 65, 67-71, and 75 are pending in the case. Claims 43, 51, 63, and 72-74 have been cancelled. Claims 41, 59, 60, 62, 64, 65, and 67-70 have been amended.

B. The Claims Are Directed to Statutory Subject Matter Under 35 U.S.C. § 101

The Examiner rejected claims 41-75 under 35 U.S.C. §101 as being directed to non-statutory subject matter. The Office Action states: “nothing in the body of the claims recite any structure of functionality to suggest that a computer performs the recited steps.” The Office Action stated that “the above deficiencies may be cured by simply explicitly reciting that the claimed method/process steps are embodied or implement on a ‘computer system’ or on a ‘computer readable medium’ (as appropriate)”.

The Applicant respectfully disagrees that claims 41-75 are directed to non-statutory subject matter. For example, claim 41 is directed to “A computer system comprising” the elements recited in the body of the claim. The elements recited in the body of the claim are therefore part of the computer system. For example, the “translator program” is part of the computer system. Therefore, claim 41 and the claims dependent thereon are clearly directed to statutory subject matter. As another example, claim 47 recites: “a method implemented on a computer system” including “providing a plurality of business rules data elements ...in a rules data table in a memory of the computer system.” [*emphasis added*]. Nonetheless, to expedite prosecution of the case, Applicant has amended claim 41 to recite “a database stored in the

computer system” and “a translator program implemented on the computer system”. Claim 47 has been amended to recite: “the computer system: using the rules style for the row in the rules data table as a key to find a matching record in the template table”. Claim 59 has been amended to recite “A computer readable medium comprising program instructions implemented on a computer system” and “the computer system: using the rules style for the row in the rules data table as a key to find a matching record in the template table”. Applicant submits that claims 41, 47, and 59 are directed to statutory subject matter. Applicant respectfully requests removal of the rejections under 35 U.S.C. §101.

C. The Claims Are Not Obvious Over Johnson in view of McKee and Reid Pursuant To 35 U.S.C. § 103(a)

The Examiner has rejected claims 41-70 as being unpatentable over U. S. Patent 4,987,538 to Johnson et al. (hereinafter “Johnson”) in view of U.S. Patent No. 6,272,482 to McKee et al. (hereinafter “McKee”) and further in view of U.S. Patent No. 6,560,592 to Reid et al. (hereinafter “Reid”). Applicant respectfully disagrees with these rejections.

In order to reject a claim as obvious, the Examiner has the burden of establishing a *prima facie* case of obviousness. *In re Warner et al.*, 379 F.2d 1011, 154 U.S.P.Q. 173, 177-178 (C.C.P.A. 1967). To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP § 2143.03.

Claim 41 has been amended to describe a combination of features including:

- a rules data table comprising a plurality of rows, each of the rows comprising a plurality of business rule data elements and a rules style;

- a template table comprising a plurality of rows, each row of the template table comprising a rules style, wherein the rules style for each row of the template table specifies a syntax for one of a plurality of business rules, wherein each of a plurality of business rules is classified

into one of the rule styles, the syntax for a premise and a resulting rule action for a given rule style being common to business rules within the rule style; and

a text table comprising a plurality of rows, each of the rows comprising a text string specifying a syntax for one of the business rules;

Support for the amendments to claims 41, 47, and 59 may be found in Applicant's specification at least on page 3, lines 14-31; page 14, line 14 to page 16, line 12; and FIGS. 3a-3c. Johnson, McKee, and Reid do not appear to teach or suggest at least the above-quoted features of claims 41, 47, and 59.

The Office Action acknowledges that Johnson and McKee do not teach or suggest business rules are classified into a plurality of rule styles, wherein a syntax for a rule premise and a syntax for a resulting rule action for a given rule style are common to business rules within the rule style. Nevertheless, the Office Action takes the position "these features are known in the art, as evidenced by Reid." Applicant respectfully disagrees with the Office Action's position. Reid teaches rules stored in a database that break down into triggers, premises, actions and alternate actions (Reid, col. 10, line 11-12). Reid further teaches using a language to specify the trigger levels, conditions, actions and alternate actions (Reid, col. 10, lines 57-67). Reid does not appear to teach or suggest a template table, each row comprising a rules style specifying a syntax for one of a plurality of business rules, wherein each of a plurality of business rules is classified into one of the rule styles, the syntax for a premise and a resulting rule action for a given rule style being common to business rules within the rule style.

Amended claim 41 further describes: "combine at least two of the business rule data elements for the row in the rules data table and the syntax for the rules style specified in the template table and the text string of the text table to form a business rule." Support for these features of amended claim 41 may be found in Applicant's specification at least on page 3, line 24-31; page 15, line 21 to page 16, line 9, and FIG. 4. Johnson, McKee, and Reid do not appear

to teach or suggest at least the above-quoted features of claims 41, 47, and 59.

Johnson states:

From the above, it will be appreciated that essentially five steps are involved in the method of processing a provider billing under this invention. These five steps can be considered to be bracketed between the step of approving the claim (thereby establishing claim identification) and pay out. The five steps are herein referred to as; (a) the rules conversion step wherein the administrative rules are converted into "computable" terms; (b) the program generating step which inputs codes and processes that enable computer processing; (c) the provider billing input step which identifies a specific provider treatment for processing under the rules; (d) the rules identification step whereby the computer program determines which rules are applicable; and (e) the computing step which determines the maximum allowable pay out.
(Johnson, col. 4, lines 26-41).

Johnson teaches a method of processing a provider billing that includes a rules conversion step in which administrative rules are converted into computable terms. The program inputs codes and processes that enable computer processing. Neither Johnson nor the other cited art appear to teach or suggest combining business rule data elements in the rules data table and syntax for the rules style specified in a template table and a text string of the text table to form a business rule.

Moreover, Applicant respectfully submits that the Office Action has not stated a motivation to combine Reid with Johnson and McKee. The Office Action states that it would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Reid within the collective teachings of Johnson and McKee "with the motivation of providing a premise which has an action, wherein the action is performed if the premise is determined to be true, an alternate action, wherein the alternate action is performed if the premise is determined to be false, and a trigger, wherein the trigger causes evaluation of the premise upon the occurrence of a predetermined event (See Reid, Col. 4, lines 54-59)." Providing a premise, alternate action, and trigger, however, appear to merely be features from the Reid disclosure, and do not provide a motivation to combine Reid with Johnson and McKee to produce the system of

claim 41.

Applicant submits that, for at least the reasons discussed above, amended claim 41 the claims depending thereon are patentable over the cited art. Applicant therefore respectfully requests removal of the 35 U.S.C. §103(a) rejections of these claims.

Amended claim 47 describes a combination of features including:

- providing a plurality of business rule data elements and a rules style for each of a plurality of rows in a rules data table in a memory of the computer system;

- providing a template table comprising a plurality of rows, each row of the template table comprising a rules style, wherein the rules style for each row of the template table specifies a syntax for one of a plurality of business rules, wherein each of a plurality of business rules is classified into one of the rule styles, the syntax for a premise and a resulting rule action for a given rule style being common to business rules within the rule style;

- providing a text table comprising a plurality of rows, each of the rows comprising a text string specifying a syntax for one of the business rules;

Amended claim 47 further describes:

- combining two or more of the business rule data elements for the row in the rules data table and the syntax for the rules style specified in the template table and the text string of the text table to form one or more business rules for processing one or more bodily injury insurance claims

For at least the reasons discussed in reference to claim 41, Applicant submits that the combination of the cited art does not appear to teach or suggest all of the features of Applicant's claim 47 and the claims dependent thereon.

Amended claim 59 describes a combination of features including:

- providing a plurality of business rule data elements and a rules style for each of a plurality of rows in a rules data table in a memory of the computer system;

- providing a template table comprising a plurality of rows, each row of the

template table comprising a rules style, wherein the rules style for each row of the template table specifies a syntax for one of a plurality of business rules, wherein each of a plurality of business rules is classified into one of the rule styles, the syntax for a premise and a resulting rule action for a given rule style being common to business rules within the rule style;

providing a text table comprising a plurality of rows, each of the rows comprising a text string specifying a syntax for one of the business rules;

Amended claim 59 further describes:

combining two or more of the business rule data elements for the row in the rules data table and the syntax for the rules style specified in the template table and the text string of the text table to form one or more business rules for processing one or more bodily injury insurance claims

For at least the reasons discussed in reference to claim 41, Applicant submits that the combination of the cited art does not appear to teach or suggest all of the features of Applicant's claim 59 and the claims dependent thereon.

C. Further Remarks

Based on the above, Applicant submits that all claims are in condition for allowance. Favorable reconsideration is respectfully requested.

If any extension of time is required, Applicant hereby requests the appropriate extension of time. It is believed that no fees are due in association with the filing of this document. If any fees are inadvertently omitted or if any additional fees are required, please charge those fees to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account Number 50-1505/5053-28000/EBM.

Respectfully submitted,



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